

## DETAILED ACTION

1. This action is responsive to communication filed 1/14/09.

### ***Response to Amendment***

2. Examiner acknowledges cancelled claims 2, 20, 25 and 31.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 3-19 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. The Federal Circuit<sup>1</sup>, relying upon Supreme Court precedent<sup>2</sup>, has indicated that a statutory “process” under 35 U.S.C. 101 must (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. This is referred to as the “machine or transformation test”, whereby the recitation of a particular machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility (See *Benson*, 409 U.S. at 71-72), and the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity (See *Flook*, 437 U.S. at

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<sup>1</sup> *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

<sup>2</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

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590"). While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform an article nor are positively tied to a particular machine that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. Regarding claim 1, the "determining and obtaining" steps could be performed manually, and do not require a machine involvement as currently claimed. Furthermore, the claim does not recite a qualifying transformation of data because there is not representation of a physical (real) object or substance and there is no recitation of an external (non-data) representation of the physical object or substance, such as a visual depiction of the physical object. Claims 3-15 depend on claim 1. Therefore are also rejected

Regarding claim 16, the "generating and determining" steps could be performed manually, and do not require a machine involvement as currently claimed. Furthermore, the claim does not recite a qualifying transformation of data because there is not representation of a physical (real) object or substance and there is no recitation of an external (non-data) representation of the physical object or substance, such as a visual depiction of the physical object. Claim 17-18 depend on claim 16. Therefore are also rejected.

Regarding claim 19, the "removing and generating" steps could be performed manually, and do not require a machine involvement as currently claimed. Furthermore, the claim does not recite a qualifying transformation of data because there is not representation of a physical (real) object or substance and there is no recitation of an

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external (non-data) representation of the physical object or substance, such as a visual depiction of the physical object.

***Allowable Subject Matter***

4. Claims 21-24 and 26-30 are allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory M. Desire whose telephone number is (571) 272-7449. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bella C. Matthew can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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G.D.

June 7, 2009

/Gregory M. Desire/  
Primary Examiner, Art Unit 2624